

REMARKS

The present application relates to hybrid maize plant and seed 38A24. Claims 5-8, 12, 20-21, 25, 33 and 41-58 have been canceled. Claims 9-11, 13-19, 22-24, 26-32, and 34-40 were previously canceled in the Preliminary Amendment submitted on July 23, 2003. Claims 1 and 2 have been amended. Claims 59-72 have been added at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. No new matter has been added by the present amendment. Applicant respectfully requests consideration of the following remarks.

Detailed Action*A. Status of the Application*

Applicant acknowledges the finality of the previous Office Action has been withdrawn pursuant to 37 C.F.R. § 1.114. Applicant further acknowledges that the rejection of claims 8, 11, 15, 19, 21, 24, 28, 32, 34, and 38-42 under 35 U.S.C. § 112, second paragraph, are withdrawn. Applicant also acknowledges that the rejection of claim 33 under 35 U.S.C. § 112, first paragraph, is withdrawn.

*B. Election/Restrictions*

The Examiner states that newly submitted claims 43-58, Group II, are directed to an invention that is independent or distinct from the invention originally claimed. The Examiner further states Group I, claims 1-8, 12, 20, 21, 25, 33, 41, and 42 are directed to hybrid maize seed 38A24; a maize plant or its parts produced from said seed; a tissue culture of regenerable cells of said plant; a maize plant regenerated from said tissue culture; said maize plant further comprising an introgressed cytoplasmic gene that confers male sterility; said hybrid maize plant wherein the genetic material contains one or more mutant genes or transgenes; a method of making hybrid maize plant 38A24 comprising crossing inbred maize plants GE533340 and GE501400; a method of producing a male sterile maize plant comprising transforming 38A24 with a transgene conferring male sterility, classified in class 800, subclass 320.1. The Examiner states Group II, claims 43-58 are directed to methods of making an F1 hybrid maize plant, comprising introgressing a mutant gene or transgene into at least one of two inbred maize plants, and then crossing the resultant plants to produce said F1 hybrid maize plant; a maize plant produced by

said method, classified in class 800, subclass 260. The Examiner states that since Applicant has received an action on the merits for the originally presented invention, Group I, this invention has been constructively elected by original prosecution for prosecution on the merits. The Examiner accordingly withdraws claims 43-60 from consideration as being directed to a non-elected invention. (37 C.F.R. § 1.142(b)). See MPEP § 821.03.

Applicant respectfully submits that the election of Group I, claims 1-8, 12, 20, 21, 25, 33, 41, and 42 is made with traverse. Applicant further submits that claims 43-58 have been canceled. However, claims 59-72 have been added at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003.

C. *Claim Objections*

Claims 8 and 21 stand rejected under 37 C.F.R. § 1.75(b) as being duplicate claims. Applicant has canceled claims 8 and 21, thereby alleviating this rejection.

**Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 5-8, 12, 21, and 25 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 5 stands rejected as indefinite for the recitation "[a] tissue culture of regenerable cells or protoplasts of said cells".

Applicant has canceled claim 5, thus alleviating this rejection.

The Examiner rejects claim 6 for the recitation "or protoplasts of said cells having been isolated from a tissue" rendering the claim indefinite.

Applicant has now canceled claim 6, thereby alleviating this rejection.

Claim 7 stands rejected as indefinite for the recitation "capable of expressing".

Applicant has canceled claim 7, alleviating this rejection.

The Examiner rejects claims 8, 12, 21, and 25 as indefinite for broadening the scope of the claim from which they depend. The Examiner states that the plants of claims 2 and 20 do not encompass any introgressed genes. The Examiner further states the claims are indefinite because

they do not present any method steps indicating how the gene was introgressed into the plant of claim 2 or 20.

Although not acceding to the Examiner's rejection, in order to expedite prosecution Applicant has now canceled claims 8, 12, 21, and 25, thus rendering this rejection moot.

Claims 12 and 25 stand rejected as indefinite for the recitation "mutant gene".

Applicant has canceled claims 12 and 25, thereby alleviating this rejection.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

#### Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 8, 12, 21, and 25 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, as stated in the Office Action mailed June 30, 2003.

Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution, Applicant has canceled claims 8, 12, 21, and 25, thus alleviating this rejection. Applicant has added new claims 59-72 at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. Applicant respectfully submits the claims now come within the purview of the written description requirement and requests reconsideration.

Claims 12 and 25 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution, Applicant has canceled claims 12 and 25, thus alleviating this rejection. Applicant has added new claims 59-72 at the request of Supervisory Patent Examiner Amy Nelson and puts the claims in form for allowance as suggested by Supervisory Patent Examiner Amy Nelson on November 7, 2003. Applicant respectfully submits the claims now come within the purview of the written description requirement and requests reconsideration.

Claims 8, 12, 21, and 25 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is more nearly connected, to make and/or use the invention.

Applicant respectfully traverses this rejection. However, in an effort to expedite prosecution, Applicant has canceled claims 8, 12, 21, and 25, thus alleviating this rejection. In addition Applicant wishes to reiterate that the actual ATCC deposit of hybrid 38A24 and inbred parents GE533340 and GE501400 has been made as provided in 37 C.F.R. §§ 1.801-1.809. Therefore, Applicant submits at least 2500 seeds of hybrid maize plant 38A24 and the inbred parents GE533340 and GE501400 have been deposited with the ATCC as disclosed in the Amendment After Final of May 16, 2003. In view of the previous amendments, the rejection under 35 U.S.C. § 112, first paragraph, should be removed. (MPEP § 2411.02) Such action is respectfully requested.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections to claims 8, 12, 21 and 25 under 35 U.S.C. § 112, first paragraph.

### Summary

Applicant acknowledges that claims 1-4, 20, 33 and 41-42 are allowed.

Applicant further acknowledges that claims 59-72 have been agreed upon as allowable by Supervisory Patent Examiner Amy Nelson as aforementioned, thereby placing these claims in form for allowance. Applicant has canceled all non-allowable claims thereby placing the application in condition for allowance and has complied with all requirements of form set forth in previous office actions.

### Conclusion

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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